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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,301	05/24/2001	Larry Hamid	12-62 US	1343

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EXAMINER	
TRUONG, THANHNGA B	

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/863,301	HAMID ET AL.	
	Examiner	Art Unit	
	Thanhnga B. Truong	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 9, 2005 (Amendment)*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment filed on June 9, 2005 has been entered. Claims 1-20 are pending. Claims 1, 2, 4-6, and 11-13 are also amended by the applicant.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Li et al (US 6,219,793).

a. *Referring to claim 1:*

i. Li teaches:

(1) storing biometric data in dependence upon a biometric characteristic of a first designated user of the secure entity or service other than the third party; capturing biometric information representative of a biometric characteristic and providing biometric data in dependence thereupon; comparing the captured biometric data with the stored biometric data to produce a comparison result; and, if the comparison result is indicative of a match: providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time (i.e., timestamp) **[i.e., an authentication method implemented on the central authentication node may be characterized by the following sequence: (a) determining that the call has been initiated from a source; (b) determining whether source fingerprint data provided from the source matches stored fingerprint data associated with the source; and (c) if the source fingerprint data**

matches the stored fingerprint data, allowing the call to be completed. Matching may involve separate matching steps at both the source and the central authentication node. It may also involve decrypting a challenge. In addition to the above basic steps, the authentication node may request that the source fingerprint data be provided from the source of the call (column 3, lines 20-40, also refer to Figure 1 and column 6, lines 52-67 through column 7, lines 1-5). Furthermore, the format of the embedded fingerprint minutiae contains a timestamp specifying the time at which the user's fingerprint was taken. The CAS would then deny access if the timestamp was not from an appropriate window in time (chosen to allow for a reasonable delay between transmission of the challenge and receipt of the newly generated fingerprint token). If a person should intercept the user's fingerprint token, not only would he/she have to extract the fingerprint minutiae, but he/she would also have to properly update the timestamp in order defeat the system. In some embodiments, the CAS only checks for timestamp, rather than examining the newly received token for an exact match to some multiple previously received tokens (column 11, lines 60-67 through column 12, lines 1-7)].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al (US 6,219,793), and further in view of Diamant et al (US 5,969,632).

a. *Referring to claim 2:*

i. Li teaches:

(1) receiving the gating signal at the secure entity or service; in response to the wireless gating signal, setting a flag within the secure entity

or service, the flag for use in gating received wireless signals for controlling access to the secure entity or service such that in a first state the secure entity or service is non responsive to the wireless signals and in a second other state the secure entity or service is responsive to the wireless signals provided by the third party **[i.e., these limitations discloses in column 4, lines 6-20].**

ii. Though Li is silent about setting a flag within the Central Authentication System (CAS) as shown in Figure 1, element 106, Diamant teaches:

(1) referring to Figure 8, steps 500 and 506 disclose the device sets a security flag to on and off **(column 13, lines 21-42).**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have applied the teaching of Diamant into the teaching of Li's CAS to securing access to data and devices when in communication over a network **(column 1, lines 22-23 of Diamant).**

iv. The ordinary skilled person would have been motivated to:

(1) have applied the teaching of Diamant into the teaching of Li's CAS since computers which are connected to WAN or LAN communication networks are vulnerable to hostile intrusion by unauthorized persons or data viruses which attempt to access classified files, download them and "crack" their encryption **(column 1, lines 15-18 of Diamant).**

b. *Referring to claim 3:*

i. Diamant further teaches:

(1) wherein the flag is returned to the first state after a predetermined amount of time **[i.e., referring to Figure 8, steps 500 and 506 disclose the device sets a security flag to on and off (column 13, lines 21-42)].**

c. *Referring to claim 4:*

i. This claim has limitations that is similar to those of claims 1 and 2, thus it is rejected with the same rationale applied against claims 1 and 2 above.

d. *Referring to claim 5:*

i. This claim has limitations that is similar to those of claim 4, thus it is rejected with the same rationale applied against claim 4 above.

e. *Referring to claim 6, 13:*

i. These claims have limitations that is similar to those of claim 2, thus they are rejected with the same rationale applied against claim 2 above.

f. *Referring to claim 7:*

i. Li further teaches:

(1) wherein the third party comprises a plurality of persons **[i.e., multiple users can be permitted to use the same wireless phone (column 15, lines 16-17)]**.

g. *Referring to claim 8:*

i. Li further teaches:

(1) wherein different persons of the plurality of persons have different predetermined access privileges **[i.e., all that is required is that the MCKD 107 at the CAS 106 be allowed to contain multiple CKs 202, one generated from each user of the same phone. Such authorization can in principle be activated/initiated by the phone owner serving as a master user who can at any time recruit additional users to be able to use their phone. By activating appropriate buttons on the phone, the master user can in principle activate the phone and the CAS 106 to receive a newly recruited user's fingerprint for association with the master user's entry in the MCKD 107. The master user can remotely authorize this action by simply validating it with his/her fingerprint. Again by engaging a pre-defined sequence of buttons on the phone the master user could also in principle remove previously authorized co-users (column 15, lines 17-30)]**.

h. *Referring to claims 9-10:*

i. These claims have limitations that is similar to those of claim 8, thus they are rejected with the same rationale applied against claim 8 above.

i. *Referring to claims 11-12:*

i. These claims consist a method for providing gated access for a third party to a secure entity or service to implement claim 4 and is rejected by the same prior art of record.

j. *Referring to claim 14:*

i. Li further teaches:

(1) wherein the wireless gating signal from the first portable biometric device and the wireless signal from the second portable biometric device are received at different ports of the secure entity or service **[i.e., CAS 106 must be able to handle, simultaneously, many calls from many wireless carriers (column 14, lines 44-45)]**.

k. *Referring to claim 15:*

i. Li further teaches:

(1) a biometric sensor for capturing biometric information representative of a biometric characteristic in response to a person presenting said information to the portable biometric device **[i.e., Figure 1 shows an apparatus that may be used to process a wireless call in accordance with the principles of the current invention. A fingerprint capturing device ("FCPD") 101 with an on-board CPU for processing and comparison of the captured fingerprint image (see Figure 4) is connected to the wireless telephone 102 (column 6, lines 52-59)]**;

(2) an encoder for digitally encoding the captured biometric information and providing biometric data in dependence thereupon **[i.e., CAS is for encrypting a challenge with the stored fingerprint data to produce an encrypted challenge (column 3, lines 48-49)]**;

(3) memory for storing biometric data indicative of a biometric characteristic of a first designated user; a processor for comparing the captured biometric data with stored biometric data to produce a comparison result, and if the comparison result is indicative of the first designated user for providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service, and if the comparison result is indicative of the third party for providing a wireless signa **[i.e., referring to Figure 1, element 101 disclose a**

fingerprint capturing module with processing and memory unit (column 7, lines 38-55)]; and,

(4) a transmitter for wireless transmission of the wireless gating signal or the wireless signal; at least a port for receiving the wireless gating signal and the wireless signal from the portable biometric device **[i.e., the connection may be by any method, i.e. via a telephone modem or a data port specifically built-in to the wireless telephone 102, an acoustic coupler, or the direct incorporation of the fingerprint module 101 into the wireless telephone 102 (column 6, lines 59-63)];** and,

(5) a locking mechanism for securing the entity or service, the locking mechanism comprising a processor for setting a flag in response to the wireless gating signal, the flag for use in gating received wireless signals for controlling access to the secure entity or service such that in a first state the locking mechanism is non responsive to the wireless signals and in a second other state the locking mechanism is responsive to the wireless signals provided by the third party **[i.e., referring to Figure 1 again, element 106, Central Authentication System (CAS) is for authenticating and/or securing the security data].**

ii. Though Li is silent about setting a flag within the Central Authentication System (CAS) as shown in Figure 1, element 106, Diamant teaches:

(1) referring to Figure 8, steps 500 and 506 disclose the device sets a security flag to on and off **(column 13, lines 21-42).**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have applied the teaching of Diamant into the teaching of Li's CAS to securing access to data and devices when in communication over a network **(column 1, lines 22-23 of Diamant).**

iv. The ordinary skilled person would have been motivated to:

(1) have applied the teaching of Diamant into the teaching of Li's CAS since computers which are connected to WAN or LAN communication networks are vulnerable to hostile intrusion by unauthorized persons or

data viruses which attempt to access classified files, download them and "crack" their encryption **(column 1, lines 15-18 of Diamant).**

l. *Referring to claim 16:*

i. Li further teaches:

(1) wherein the portable biometric device comprises memory for storing biometric data indicative of a biometric characteristic of the third party **[i.e., referring to Figure 1, element 102 include storage for storing user's fingerprint that is sent from device 101].**

m. *Referring to claim 17:*

i. This claim has limitations that is similar to those of claim 14, thus it is rejected with the same rationale applied against claim 14 above.

n. *Referring to claims 18-20:*

i. These claims consist a security system for securing an entity or a service from indiscriminate access to implement claim 15 and is rejected by the same prior art of record.

Response to Argument

6. Applicant's arguments filed June 9, 2005 have been fully considered but they are not persuasive.

Applicant argues that:

Independent claims 11 and 15 is not obvious in light of the combination of Li and Diamant

Examiner totally disagrees with the applicant and still maintains that:

The combination between Li and Diamant teach the claimed subject matter. In fact, Diamant further teaches referring to Figure 13, in step 1056, if the time period .alpha. is greater than or equal to a predetermined period of time T, then the controller 1004 proceed to step 1060. Otherwise, the controller 1004 proceeds to step 1058. In step 1058, the controller 1004 denies access to the to the storage area 1002. (column 17, lines 64-67 through column 18, lines 1-2 of Diamant). In addition, Figure 8 is a schematic illustration of a method for operating communication controllers shown in FIGS. 1, 6 and 7 which uses the security flag (column 13, lines 21-60 of Diamant).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of teachings between Li and Diamant are sufficient.

Li and Diamant do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations.

For the above reasons, it is believed that the rejections should be sustained.

Conclusion

7. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The central fax number for the organization where this application or proceeding is assigned is **571-273-8300.**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Please notice that the central fax number has changed. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number only until September 15, 2005. (Note that since this new number is already operational, customers can use either number until September 15).

TBT
August 18, 2005

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100